

REMARKS

In response to the Office Action mailed February 17, 2011, the Assignee of the present application (Nuance Communications Austria GMBH) respectfully requests reconsideration. Claims 1-19 have been presented for examination. All have been rejected. Herein, claims 1, 3, 6, 8, 13, 14 and 19 have been amended (without prejudice or disclaimer) and claims 2, 9 and 15 have been canceled. No claims have been added. No new matter has been added.

Request to Withdraw Finality

The Office Action of February 17 has prematurely been made final. A new provisional double patenting rejection has been presented. It is new for two reasons: first, it rejects claims not previously rejected and second, it rejects these claims over claims 21-46 of co-pending application 10/595831, whereas the previous double patenting rejection had been over now-canceled claims 1-20. No amendment of any of rejected claims 1-19 *herein* caused the addition of claims 1-3, 6-7, 10, 13, 16 and 19 to the list of provisionally rejected claims. If amendment of the claims in the '831 application justified the new provisional double patenting rejection it is, nonetheless, a new rejection presented for the first time and not necessitated by any amendment herein. Hence, the Office Action has prematurely been designated as Final. Assignee requests that the finality be withdrawn.

Provisional Double Patenting Rejection

Claims 1-19 have been provisionally rejected on the ground of non-statutory obviousness-type double patenting over claims 21-46 of co-pending application no. 10/595831. As this is only a provisional rejection, Assignee holds in abeyance the potential filing of a terminal disclaimer or argument.

Rejections Under 35 U.S.C. §101

Claims 1, 2, 4, 5, and 14-19 stand rejected under 35 U.S.C. §101 as being as directed to non-statutory subject matter. As the Office Action incorrectly analyzes the claims and does not apply the latest case law, and as some claims have been amended, reconsideration is requested.

In *Research Corp. Techs. v. Microsoft Corp.*, No. 2010-1037 (Fed. Cir. Dec. 8, 2010), the Court of Appeals for the Federal Circuit, in an early post-*Bilski* decision, effectively rendered obsolete the Office's current *Interim Guidance for Determining Subject Matter Eligibility for Process Claims in View of Bilski v. Kappos*, 75 Federal Register 43922 (July 27, 2010), which instructs examiners to apply the machine or transformation test to all method claims and put the onus on the applicant to explain why failure to satisfy that test is not fatal. Chief Judge Rader, writing for a Federal Circuit panel, began by noting that the claim (which involved digital halftoning) literally specified a process, so the operative question was whether any judicially created exception (of which there are three, laws of nature, physical phenomena and abstract ideas) applied, framing the focus of his analysis thusly:

“As a process, the subject matter qualifies under both the categorical language of section 101 and the process definition in section 100. Therefore, this court proceeds to examine the Supreme Court's three exceptions. The parties do not dispute, and this court agrees, that the inventors do not purport to have invented laws of nature or physical phenomena. Therefore, this court turns to abstractness.”

This language applies with equal force to claims 1-7 herein.

Regarding abstractness, Judge Rader set a very high bar:

“[T]his court . . . will not presume to define “abstract” beyond the recognition that *this disqualifying characteristic should exhibit itself so manifestly as to override the broad statutory categories of eligible subject matter* and the statutory context that directs primary attention on the patentability criteria of the rest of the Patent Act. In that context, this court perceives nothing abstract in the subject matter of the processes claimed in the '310 and '228 patents.” (Emphasis added.)

Why was there nothing abstract about the claimed method? Judge Rader answered clearly:

“The invention presents *functional and palpable applications* in the field of computer technology. These inventions *address “a need* in the art for a method of and apparatus for the halftone rendering of gray scale images in which a digital data processor is utilized in a simple and precise manner to accomplish the halftone rendering.” ’310 patent col.3 ll.33-40.” (Emphasis added.)

Thus, a method that addresses a functional need in that art, as the claimed method herein, does not claim something abstract, and defines statutory subject matter. The rejection of claims 1, 2, 4 and 5 as drawn to non-statutory subject matter therefore should be withdrawn.

Claims 14 - 19 were rejected on the ground that a “computer readable medium” encompasses non-statutory subject matter. However, the Office Action fails to address that the claims do not recite “computer readable medium.” They recite “computer readable *storage* medium.” The preambles also identify the subject matter as a “product.” Even if by some distorted reading of the word a product is construed to encompass a transitory signal, Office personnel (both other examiners and the OPLA) have acknowledged that a storage medium is not a transitory signal. Moreover, the now outdated (by virtue of changes in case law) *Interim Guidelines* allow for alternatives other than “non-transitory” to assure that the claimed medium encompasses only statutory subject matter. If the Examiner doubts that “storage medium” is sufficient to limit the claims to statutory subject matter, he is invited to contact the undersigned, who will authorize, if necessary, an Examiner’s Amendment to limit the claim to “non-transitory computer-readable storage medium,” the adjective “non-transitory” (which the Director indicates not to raise new matter concerns), being redundant.

Further, claim 1 has been amended to incorporate the limitation from claim 3 (which was not rejected on subject matter grounds) the text was generated by a first speech recognition pass. A similar amendment is made to claim 14. No such amendment has been made to claim 19, for which Assignee relied on the foregoing argument and the *RCT* decision. Even the Office Action already

accepts the premise that speech processing is in the realm of the concrete and applied, not the abstract.

Consequently, the rejections under section 101 should be withdrawn.

Rejections Under 35 U.S.C. §102

Claims 1-19 stand rejected under 35 U.S.C. §102(e) as purportedly being anticipated by U.S. Patent No. 6,529,902 (Kanevsky). Without conceding agreement with the Office Action, at least in light of the foregoing amendments, the rejection should be withdrawn.

Claim 1 has been amended to include the limitation of claim 2 that “the text modification procedure compris[es] a text formatting process for which the assigned statistical model provides formatting rules specific for a topic of the section.” The Office Action, on page 6, cites “formatting rules (412, 414, 418, 420)” – but those are ASSIGNEE’s rules on ASSIGNEE’s FIG. 4, not those of Kanevsky, as the Office Action puts forth. Moreover, the undersigned has performed text searches on Kanevsky and has scoured the drawings of that reference, and has re-read the specification of Kanevsky and can find no such reference numerals and no textual discussion of the application of formatting rules. Substantially all the Kanevsky says about what happens after a topic of a segment is established is found in col. 12 at lines 9-17. There is nothing about formatting. (As an aside, Assignee notes that the European Patent Office, as ISA, found that claim 1, BUT NOT CLAIM 2, lacked novelty over Kanevsky.) Thus, Kanevsky does not even address one of the objectives of the present claims – to present content in a section-appropriate format (e.g., using numerals in one section while using words for numbers in another section), and the corresponding limitation from claim 2 and parallel dependent claims, now incorporated into their respective independent claims.

Since Kanevsky does not disclose each and every limitation of the independent claims, this rejection should be withdrawn.

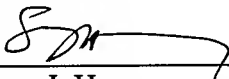
CONCLUSION

In view of the above amendments and argument, Assignee believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 23/2825 under Docket No. N0484.70064US00 from which the undersigned is authorized to draw.

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Respectfully submitted,

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